

IV. REMARKS

Claims 1-2 and 4-30 are pending in this application. By this amendment, claims 1, 7, 10, 12, 16, 19, 23, 26 and 28 have been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. §1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicant respectfully requests entry of this Amendment.

A. 35 U.S.C. §112

In the Final Office Action, claims 1-30 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description. Final Office Action, p. 2. In support of its rejection, the Office asserts that the “newly added matter places on the template ‘an occurrence of the risks.’” *Id.* However, Applicants submit that the previous claim amendment(s), including “identifying an occurrence of the risks in the business process” clarifies and further defines the function(s) of the set of tests to be performed by a test entity. *See* claim 1. Applicants submit that the above mentioned claim amendment(s) does not place on the template “an occurrence of the risks,” per se, as asserted by the Office, but instead further clarifies and defines the function(s) of the set of tests. Applicants respectfully refer the Office to pg. 14, line 20 – pg. 15, line 9 of Applicants original disclosure, wherein the detailed description

provides, *inter alia*, that a set of tests or checks is performed on the business process to identify whether a risk has occurred (or will occur). Accordingly, Applicants submit that claims 1-2 and 4-30 contain subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed, had possession of the claimed invention and respectfully request withdrawal of the rejection.

Furthermore, the Office asserts that “Applicant’s canceling of claim 2 is quasi-suspicious in that the template dealt with, identifying actions to address the risks and arranging on said template, then perform(ing) an audit using said template.” Final Office Action, p. 2. Applicants initially point out that claim 2 is still pending in the application. Even assuming, *arguendo*, that the Office intended to refer to cancelled claim 3, Applicants submit that incorporating subject matter from dependent claim 3 in to independent claim 1 is not quasi-suspicious. Applicants respectfully request further clarification or withdrawal of the rejection.

B. 35 U.S.C. §102

In the Final Office Action, claims 1-29 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by the following: the public activities as of May 5th, 2000 of Keane Inc., the Keane Inc. website as of May 5th, 2000, and Keane Inc.’s published PRAM reference. Office Action, p. 6. Reconsideration in view of the following remarks is respectfully requested.

With respect to independent claims 1, 7, 10, 12, 16, 19, 23, 26, and 28, Applicants submit that the PRAM reference fails to disclose each and every feature of the claimed invention, including “arranging information pertaining to the control points in a standard format using a separate template for each control point and storing the template in a computer database to

provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process.”

Interpreting the PRAM reference only for purposes of this response, Applicants submit that the PRAM reference discloses a risk profile (figure 3) with all the key risks on one page. Page C, section V. As shown in figure 3 of the PRAM reference, each risk variable (Stable Specs, SME’s Available as Scheduled, etc.) is listed in the same profile/template. In contrast, the present invention discloses, *inter alia*, a method for reviewing a business process that includes a separate template for each control point for arranging business process review information. As recited by claim 1 (and as similarly recited by claims 7, 10, 12, 16, 19, 23, 26, and 28), the present invention discloses, *inter alia*, “arranging information pertaining to the control points in a standard format using a separate template for each control point and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process.” This allows all review information for a particular control point to be arranged in a separate template and stored so that reviewers, auditors or the like can refer to the template to accurately and efficiently perform their duties. The PRAM reference, however, fails to disclose this claimed feature. Accordingly, Applicants submit that the PRAM reference fails to disclose each and every element of claim 1 and respectfully request withdrawal of the rejection.

With respect to independent claims 7, 10, 12, 16, 19, 23, 26, and 28, Applicants herein incorporate the arguments made above with respect to claim 1. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With respect to dependent claims 2, 4-6, 8-9, 11, 13-15, 17-18, 20-22, 24-25, 27, and 29, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

C. 35 U.S.C. §103(a)

In the Final Office Action, claims 1-30 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over PRAM, in further view of Official Notice. Final Office Action, p. 6. In support of its rejection, the Office asserts that the PRAM reference discloses “all of the limitations as discussed above; the method in which nearly all consultants analyzing risk normally use and steps and considerations made (i.e., id risk, determine how to mitigate, and keep track on a template). PRAM does not discuss the use of the internet and an access field that includes a hypertext link that would allow direct access to a field as claimed.” *Id.* In response, Applicants again submit that only claims 27 and 30 recite the use of a hyper link. Applicants submit that a rejection under 35 U.S.C. 103(a) as being unpatentable over PRAM in further view of Official Notice is inappropriate with respect to all the claims (1-2 and 4-30). Furthermore, Applicants submit that the PRAM reference, either singly or in combination with the Office’s Official Notice, fails to disclose each and every element of the claimed invention. As discussed above, Applicants submit that the PRAM reference fails to disclose, *inter alia*, the step of “arranging information pertaining to the control points in a standard format using a separate template for each control point and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the

business process.” (See claim 1, and as similarly recited by claims 7, 10, 12, 16, 19, 23, 26, and 28.) The Office’s Official Notice fails to cure this deficiency. As a result, Applicants submit that the Office has failed to make out a prime facie case of obviousness and respectfully requests withdrawal of the rejection. Finally, with regard to the 35 U.S.C. §103(a) rejection of claims 27 and 30 over the PRAM reference and further in view of Official Notice, Applicants assert that the Office’s factual assertion is not properly based upon common knowledge. For example, Applicant asserts that a computer implemented template comprising an information access field for arranging background information, wherein the information access field includes at least one hypertext link that allows direct access to the background information is not obvious to one skilled in the art as asserted by the Office. Accordingly, Applicants respectfully request that the Office support the finding with references that show these features.

With respect to independent claims 7, 10, 12, 16, 19, 23, 26, and 28, Applicants herein incorporate the arguments made above with respect to claim 1. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With respect to dependent claims 2, 4-6, 8-9, 11, 13-15, 17-18, 20-22, 24-25, 27, and 29-30, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

V. CONCLUSION

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

/Darrell L. Pogue/

Darrell L. Pogue

Reg. No.: 57,878

Date: February 20, 2007

Hoffman, Warnick & D'Alessandro LLC
75 State Street
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)